

REMARKS

Claims 9-21, 26 and 27 currently appear in this application. The Office Action of February 27, 2006, has been carefully studied. These claims define novel and unobvious subject matter under Sections 102 and 103 of 35 U.S.C., and therefore should be allowed. Applicant respectfully requests favorable reconsideration, entry of the present amendment, and formal allowance of the claims.

Rejections under 35 U.S.C. 112

Claims 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. New claims 24 and 25 are said to recite that the galvanized alloy plating is not subsequently treated with chromate, and thus recite a negative limitation.

This rejection is respectfully traversed. The present amendment cancels claims 24 and 25 and submits new claims 26 and 27. These new claims use the limited term "consisting", so that further treatment, including subsequent treatment with chromate, is excluded.

Claims 9-21, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is respectfully traversed. Claims 9 and 10 have been amended to clarify the language of the claims regarding the solution.

Art Rejections

Claims 9-12 and 15-17 are rejected under 35 U.S.C. 103(b) as being anticipated by Saitou et al., U.S. Patent No. 5,032,236.

This rejection is respectfully traversed. The anodic treatment as claimed herein produces a different steel sheet from that produced by the process of Saitou. In Saitou, at column 4, lines 58-64, describe production of a black film. In this process, as black film can be obtained at all only by the use of the metal ion, the oxidizing ion, the oxidizing ion and organic hydroxy compound, are all required. The oxidizing ion is a component that oxidizes a part of the metal (Zn, Fe, Co and Ni) deposited by reduction at the cathode to electrically deposit a black complex plating as a hydrated oxide. However, in the steel sheet claimed herein, the surface of the galvanized alloy steel is oxidized in solution by an anodic treatment, which means that the oxidizing ion and organic hydroxy-compounds are not required to produce the black coating. Since the coating of the present steel sheet

is formed with fewer ions in the plating solution, it is clear that there would be fewer impurities in the coating produced.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitou et al. in view of Smith.

This rejection is respectfully traversed. As noted above, the anodic process claimed herein produces a steel sheet produced with fewer extraneous ions in the plating bath. The fact that Smith discloses an aqueous polyurethane dispersion having a higher modulus that may be used to coat cold rolled steel plates is immaterial, because Smith is silent with respect to steel sheets that have been treated to form a galvanized alloy thereon. There is nothing in Smith that even suggests that the coatings described therein could be used on a galvanized steel sheet and have the same physical properties.

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizaka et al. in view of Saitou et al.

This rejection is respectfully traversed. Film cartridges made of steel do not suggest film cartridges made of resin coated steel sheet as claimed herein. There is no motivation to provide a surface blackened steel sheet of Saitou for producing a film cartridge, because Ishizaka

discloses nothing about any type of coating on the steel.

Ishizaka merely notes that steel is a convenient material for making film cartridges because a film cartridge is loaded into a film chamber, it is attracted by permanent magnets.

As the Federal Circuit stated in *In re Lee*, 61 USPQ2d 1430 (January 18, 2002, Fed. Cir.), "As applied to the determination of patentability *vel non*, when the issue is obviousness, 'it is fundamental that rejections under 35 U.S.C. 103 must be based on evidence comprehended by the language of that section.' *In re Grasselli*, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000)... When patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ('the central question is whether there is a reason to combine [the] references,' a question of fact drawing on the *Graham* factors."

'The factual inquiry whether to combine references must be thorough and searching.' *Id.* This precedent has been reinforced in myriad decisions, and cannot be dispensed with, See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). ('a showing of a

suggestion, teaching, or motivation to combine the prior art references is an "essential component of an obviousness holding"') (quoting *C. R. Bard, Inc. v. M3 Systems, Inc.* 48 USPQ2d (Fed. Cir. 1998)) The Court went on to quote *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."

There is a requirement for specificity in combining references, *See, In re Kotzab*, 55 USPQ2d 13134, 1317 (Fed. Cir. 2002) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.").

In the present case, the Examiner has shown no motivation to use the coated steel of Saitou in the film cartridge of Ishikawa.

In view of the above, it is respectfully submitted that the claims are now in condition for allowance, and favorable action thereon is earnestly solicited.

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Respectfully submitted,

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